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In re Application of:	:	
NORDHOFF, Eckhard, et al.	:	DECISION ON SECOND
U.S. Application No.: 10/576,644	:	RENEWED REQUEST UNDER 37
Int'l Application No: PCT/EP2004/011878	:	CFR 1.497(d) AND RENEWED
Int'l Filing Date: 20 October 2004	:	PETITION FOR REVIVAL
Priority Date: 23 October 2003	:	UNDER 37 CFR 1.137(b)
Attorney's Docket No.: 39412.00.0002	:	
For: METHOD AND DEVICES FOR	:	
DEPOSITING SAMPLES ON AN	:	
ELECTRICALLY SHIELDED	:	
SUBSTRATE	:	

This decision is issued in response to the "Renewed Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.136(b) And Renewed Request Under 37 CFR 1.497(d)" filed 09 September 2010. Applicants have previously filed the petition fee required for the petition for revival and the processing fee required with respect to the request under 37 CFR 1.497(d).

**BACKGROUND**

The procedural background for the present application was set forth in the decisions mailed on 08 May 2008 and September 10, 2009.

The decision mailed 08 May 2008 dismissed without prejudice applicants' request under 37 CFR 1.497(d) to add four additional inventors to the present application. Specifically, the decision indicated that applicants had not provided the consent of the assignee required for such a request to be grantable, and that the filed declaration was an unacceptable compilation of multiple documents. The decision provided an extendable two-month period for applicants to file a request for reconsideration (accompanied by the additional required materials).

Applicants did not file a response to the 08 May 2008 decision during the available response period. Accordingly, the present application became abandoned as of midnight on 08 July 2008.

On 16 March 2009, applicants filed a petition for revival, accompanied by a renewed request to correct inventorship under 37 CFR 1.497(d) and a revised declaration.

The decision mailed on 10 September 2009 dismissed without prejudice applicants' renewed request under 37 CFR 1.497(d), indicating that the consent of the assignee filed by applicants was defective because it was not accompanied by a statement in compliance with 37 CFR 3.73(b) and the revised declaration was defective because it failed to identify the citizenship of all of the inventors. The decision also dismissed without prejudice the petition for revival under 37 CFR 1.137(b) because applicants had failed to provide the "required reply," that is, the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d) to correct inventorship and an acceptable declaration executed by the inventors. The decision again provided an extendable two-month period for applicants to file a request for reconsideration (accompanied by the additional required materials). Applicants did not file a response to the 10 September 2009 decision during the available response period.

On 09 September 2010, one year after the mailing of the previous decision, applicants filed the Renewed Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.136(b) And Renewed Request Under 37 CFR 1.497(d)" considered herein, accompanied by a second revised declaration.

### **DISCUSSION**

#### **1. Second Renewed Request To Correct Inventorship (37 CFR 1.497(d))**

The present submission includes an executed "Statement under 37 CFR 3.73(b)" (Form PTO/SB/96) from assignee Scienion AG. The Form PTO/SB/96, coupled with the previously submitted "Declaration Of Scienion AG," provides an acceptable statement of consent to the requested change in inventorship, satisfying the assignee's consent requirement set forth in 37 CFR 1.497(d)(3).

However, a grantable request to correct inventorship under 37 CFR 1.497(d) requires the submission of an acceptable declaration in compliance with 37 CFR 1.497 that names and is executed by all the inventors, including those being added, and applicants here have again failed to submit such a declaration. As stated in the decision mailed on 08 May 2008, the original declaration filed herein on 16 November 2007 was unacceptable because it consisted of a compilation of multiple documents. The revised declaration filed by applicants on 16 March 2009 resolved the compilation defect; however, as indicated in the decision mailed on 10 September 2009, that revised declaration was unacceptable because it failed to include the citizenship of all the inventors, as required under 37 CFR 1.497(a)(3). Now, applicants have submitted four re-executed declaration signature pages which include the citizenship of all the inventors; however, this compilation of signature pages was not submitted as part of complete declarations in compliance with 37 CFR 1.497. Because applicants have not filed complete declarations acceptable under 37 CFR 1.497, the renewed request to correct inventorship is not grantable on the present record.<sup>1</sup>

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<sup>1</sup> It is noted that applicants' present submission states that "previous declarations by inventors Nordhoff and Bullock have been accepted." This is incorrect. To date, applicants have not submitted a complete declaration acceptable under 37 CFR 1.497 with respect to any of the inventors, including the original inventors of record Eckhard NORDHOFF and Alan BULLOCK.

## 2. Renewed Petition For Revival (37 CFR 1.137(b))

As indicated in the previous decision, a grantable petition for revival under 37 CFR 1.137(b) must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). The present renewed petition fails to satisfy items (1) and (3) above.

With respect to item (1), the "required reply" here is a proper response to the decision mailed on 08 May 2008, that is, the materials required to satisfy the final element of a grantable request under 37 CFR 1.497(d) to correct inventorship and an acceptable declaration executed by the inventors. As discussed above, applicants' present submission includes the materials required to satisfy the previously incomplete assignee's consent element of a grantable request under 37 CFR 1.497(d); however, applicants have not filed acceptable declarations executed by all the inventors. Accordingly, applicants have not submitted the "required reply" and item (1) of a grantable petition for revival therefore remains unsatisfied.

With respect to item (3), the renewed petition for revival is accompanied by a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." However, under the circumstances present here, applicants must provide a more detailed explanation (with appropriate supporting documents) explaining the one year delay in responding to the 10 September 2009 decision. Such materials are required before it can be concluded that the entire delay herein, including the additional delay in filing a response to the 10 September 2009 decision, was unintentional. Until such additional materials are provided, item (3) of a grantable petition for revival is unsatisfied.

### CONCLUSION

The renewed petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The second renewed request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should be entitled "Second Renewed Petition Under 37 CFR 1.137(b) and Renewed Request Under 37 CFR 1.497(d)" and it must include: (1) the materials required to complete the "required reply," that is, complete copies of an acceptable declaration(s) executed by each of the inventors herein that includes all required information, including the citizenship of each of the inventors, and (2) a detailed explanation, with appropriate supporting documents, demonstrating that the entire delay herein, including the one-year delay in responding to the decision mailed on 10 September 2009, was unintentional.

No additional petition fees are required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459